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EXAMINER

PASCUA, JES F

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| ART UNIT | PAPER NUMBER |
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3727

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 14

Application Number: 09/859,451
Filing Date: May 18, 2001
Appellant(s): MOGIL, MELVIN S.

Charles M. Marmelstein
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 10, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 23-27 and 29-44 have been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: The only issue on appeal in this matter is whether claims 1, 2, 4, 19-22 and 28 are unpatentable under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,877,128 to Strickland.

The Examiner's consideration of the terms "maintainable" and "securable" as used in claims 1 and 28 were not treated as separate grounds of rejection and therefore is not an issue for appeal.

(7) Grouping of Claims

The rejection of claims 1, 2, 4, 19-22 and 28 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

| | | |
|-----------|------------|---------|
| 4,877,128 | Strickland | 10-1989 |
|-----------|------------|---------|

(10) Grounds of Rejection

The following ground of rejection is applicable to the appealed claims:

Claims 1, 2, 4, 19-22 and 28 are rejected under 35 U.S.C. 102(b). This rejection is set forth in prior Office Action, Paper No. 8.

(11) Response to Argument

Appellant argues that "the term 'maintainable' as it is used in claim 1 expresses a feature of the claimed insulated container" by defining "different environmental conditions" of "the first and second chambers" of "the insulated container". In response, appellant's "different environmental conditions" are not positive structural limitations of

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the claimed invention, but merely a function of "the first and second chambers" of "the insulated container". Strickland clearly shows at least first and second chambers 11a of an insulated container and therefore capable of maintaining a different environmental conditions between the first and second chambers. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Appellant then argues that "the term 'securable' as it is used in claim 28 also expresses a feature of the claimed insulated container" by defining "the collapsed position" of "the first container portion relative to the common wall" of the "insulated container". In response, appellant's term "securable" is not a positive structural limitation of the claimed invention, but merely a function of the first container portions of the insulated container. Strickland clearly shows an insulated container (which include first/second container portions 11, 16, 17 and common walls 12) in a collapsed position. See Fig. 4. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). As a note, the container portions 11, 16, 17 of Strickland are moveable between an expanded position and a collapsed condition relative to the common walls to same degree that appellant defines "relative" in the claim. Moreover, the first container Claim 28 fails to recite any structure that would permit the first container portion to be secured in a collapsed position.

Regarding appellant's arguments that Strickland does not anticipate the structure of claims 1 and 28, appellant's attention is directed to Figs. 2 and 3 of Strickland. On the left half of the insulated container, Strickland shows two, first chambers and on the right half are two, second chambers. The first and second chambers are located side-by-side; separated by common wall 12. The first chambers are surrounded by the left half of walls 11, 16, 17 to form first collapsible insulated container portions having respective first wall structures and including respective sidewall panels. The second chambers are surrounded by the right half of walls 11, 16, 17 to form second collapsible insulated container portions having respective second wall structures and including respective sidewall panels. The first and second chambers of Strickland are insulated on those sides surrounded by insulating wall 17. There is no limitation in appellant's claim 1 that explicitly requires the chambers to be entirely insulated. Regarding appellant's argument that Strickland does not teach or describe the first chamber being maintainable at a different environmental condition from the second chamber, the Examiner maintains that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform; even in light of defining the structural attributes of interrelated component parts of the claimed assembly.

Regarding appellant's argument that Strickland is missing the liner of claims 2 and 4, it is put forth by the Examiner that the bottles 14 of Strickland meet the structure of appellant's claimed liner.

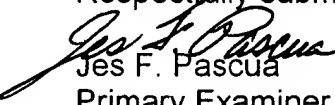
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In response to appellant's argument that Strickland fails to show a certain feature of appellant's invention, it is noted that the feature upon which appellant relies (i.e., the direction of collapse being toward the common wall) is not recited in rejected claim 28. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellant's arguments concerning claims 19-22 are silent except that appellant relies on the arguments made in the context claim 1. In light of the Examiner's remarks above, claims 19-22 remain anticipated by Strickland.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Jes F. Pascua
Primary Examiner
Art Unit 3727

JFP

January 7, 2003

Conferees

Stephen P. Garbe, Primary Examiner 

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